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Patent Docket No. P2827RL
TECH CENTER 1600/29C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Diane Pennica et al. Serial No.: 09/759,056 Filed: 11 January 2001 For: NOVEL STRA 6 POLYPEPTIDES	Group Art Unit: 1631 Examiner: Michael L. Borin
<p>CERTIFICATE OF MAILING I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, Washington, DC 20231 on</p> <p style="text-align: center;"><u>August 7, 2002</u> <u>Pamela Gavette</u> Pamela Gavette</p>	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

This paper is responsive to the Office Action mailed May 20, 2002, setting forth a restriction requirement in connection with the above-identified application. A response to the restriction requirement was initially due on June 20, 2002. A petition and fee authorization for a two month extension of time is submitted herewith extending the time for response until August 20, 2002. Accordingly, this paper is timely filed.

Reconsideration of the application is requested in view of the remarks herein.

REMARKS

Claims 1-95 were pending. The Office Action stated that an election of claims from 32 groups is required. Applicants hereby elect the claims of Group I (claims 1-4, 9-11, 15, 16, 18-21) with traverse. With this election, claims 1-4, 9-11, 15, 16, 18-21 are under consideration. Applicants withdraw claims 5-8, 12-14, 17, 22-95 from consideration. Applicants expressly reserve the right under 35 U.S.C. §121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

With respect to sequence election, Applicants further elect DNA molecule encoding a PRO10282 polypeptide comprising the sequence of amino acid residues from about 1 to about 667 of Figure 2 (SEQ ID NO:2) (as in (a) & (c) of pending claim 1).

Applicants request examination of the elected subject matter on the merits.

Applicants traverse the restriction requirement because the Office has not demonstrated any burden upon it to search, for example, the combined groups of Group I, II, III, IV, V, XVI and XVII. (See MPEP §803, second full paragraph: "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.") The Office Action indicates that the claims in these groups are classified in the same and/or overlapping class and subclass (class 536, subclass 23.1 and class 935, subclass 66). Applicants respectfully submit that there is no additional burden in searching the claims of these groups, since the same references will be reviewed for the relevant claims.

Therefore, restriction among these groups is improper at this time. However, should the restriction be maintained, Applicants urge the Office to search and examine the non-elected species should a generic claim be found allowable.

In the unlikely event that the transmittal letter is separated from this document and the U.S. Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Director to charge the cost of such petitions and/or other fees due in connection with the filing of this document to our Deposit Account No. 07-0630.

Respectfully submitted,
GENENTECH, INC.

Date: August 7, 2002

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PATENT TRADEMARK OFFICE